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10/826,272	04/19/2004	Kazuhiro Fujii	SN-US045038	9912

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GLOBAL IP COUNSELORS, LLP		
1233 20TH STREET, NW, SUITE 700		
WASHINGTON, DC 20036-2680		

EXAMINER	
LUONG, VINH	

ART UNIT	PAPER NUMBER
3682	

MAIL DATE	DELIVERY MODE
11/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,272

Applicant(s)

FUJII, KAZUHIRO

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007 and 10 August 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-21 is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2007 and 19 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

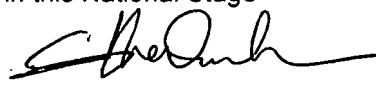
Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/25/07.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Attachment.

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1. The Amendments filed on August 2 and 10, 2007 have been entered.
2. Applicant's election without traverse of the species of FIGS. 1-16 in the reply filed on January 10, 2007 is acknowledged.
3. No claim is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 10, 2007.
4. The drawings were received on August 2, 2007. These drawings are unacceptable by the Examiner because the amendments in the drawings do not comply with 37 CFR 1.121 for the reasons, *inter alia*, listed below.

(a) The amended drawings introduce new matter. See 37 CFR 1.121(f). For example, the plane P as now shown in Fig. 7 introduces new matter. The original disclosure does not disclose the plane P. See paragraph [0064] of the original specification. The specific showing of the plane P within a full spectrum of possible planes disposed on an opposite side from the split S is considered under the present disclosure to be new matter. *Cf., In re Smith*, 173 U.S.P.Q. 679 (CCPA 1972) and *Ex parte George*, 230 U.S.P.Q. 575, 578 (Bd. Pat. App. & Inter. 1986). In other words, the concept that the plane P is perpendicular to the operating axis X and passes through the center axis C of the transverse portion T of the handlebar 14 as now shown in FIG. 7 is not conveyed in the original disclosure, thus, it is new matter. *In re Anderson*, 176 USPQ 331 (CCPA 1973). See 37 CFR 1.81(d) and 35 USC 113; and/or

(b) 37 CFR 1.121(d) states: "[a]ll changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper." However, Applicant did not explain the changes, such as, the adding of the plane P in FIG. 7 in either the drawing

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amendment or remarks section of the amendment paper. See pages 11-13 of the amendment on August 2, 2007.

5. The *original* drawings are objected to because the drawings are not in compliance with 37 CFR 1.84. See PTO Form-948 attached.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The amendment filed August 2, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is, *e.g.*, as follows: the new description of the plane P in paragraph [0064] of the specification. The original disclosure does not disclose the plane P. The

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specific description of the plane P within a full spectrum of possible planes disposed on an opposite side from the split S is considered under the present disclosure to be new matter. *Cf., In re Smith* and *Ex parte George, supra*. In other words, the concept that the plane P is perpendicular to the operating axis X and passes through the center axis C of the transverse portion T of the handlebar 14 as now shown in FIG. 7 is not conveyed in the original disclosure, thus, it is new matter. *In re Anderson, supra*. Applicant is required to cancel the new matter in the reply to this Office Action.

7. The disclosure is objected to because of the following informalities: the specification should specify which figures show the retained and detached positions in Claims 1, 18, and 28. See 37 CFR 1.84(h)(4). Appropriate correction is required.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 11-18 and 22-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended Claim 11 recites "a bicycle computer unit (24) including a display screen (56) *directly* supported by the first tubular clamping member (36) of the first mounting portion (30) such that the bicycle computer unit (24) is *only* indirectly supported by the bicycle handlebar (14)." (Reference characters and emphasis added).

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The terms “*directly*” and “*only*” are unsupported by the original record. In fact, paragraphs [0048], [0054], and [0055] of the specification describe and FIG. 3 shows that the computer unit 24 is indirectly supported by the clamping member 36 because the unit 24 is connected to the clamping member 36 by the computer support legs 40. In other words, the bicycle computer unit 24 is indirectly supported by the bicycle handlebar 14, support legs 40, and fasteners, etc. See MPEP 2163.01.

Amended Claim 22 recites: “the plane (P) passing through a center axis (C) of the handlebar (14) and being perpendicular to the operating axis (X).” (Referential character added).

The plane P in the above quotation is unsupported by the original record. In fact, on the filing date, the specification did not describe and the drawings did not show the plane passing through a center axis (C) of the handlebar (14) and being perpendicular to the operating axis. The first time that the plane P appeared in the record was the time of filing of the amendment on August 2, 2007. Therefore, Claims 22-31 contains subject matter (i.e., the plane P) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See MPEP 2163.01, *supra*.

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-18 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The terms, such as, “slidable” in Claims 1, 18, and 28, and “movable” in Claim 2 are vague and indefinite in the sense that things which may be done are not required to be done. For example, in Claims 1, 18, and 28, the switch portion (32) is slidable *but is not structurally required to be* slid relative to the mounting portion. See “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “crimpable” in *Application of Collier*, 158 USPQ 266 (CCPA 1968), “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

It is unclear whether a confusing variety of terms, such as, “a switch mounting structure (38),” “a tubular clamping member (36),” and “a mounting portion (30)” in Claim 1 refer to the same or different things. In other words, it is unclear whether the recitation “a switch mounting structure (38) *fixedly coupled* to the tubular member (36)” in Claim 1 implies that the switch mounting structure 38 and the tubular member are formed as different/separate pieces or not. FIG. 9 shows that they are the same because they are formed as one piece. See MPEP 608.01(o) and double inclusion in MPEP 2173.05(o).

The recitation “a bicycle computer unit (24) including a display screen (56) *directly* supported by the first tubular clamping member (36) of the first mounting portion (30) such that the bicycle computer unit (24) is *only* indirectly supported by the bicycle handlebar (14)” (reference characters and emphasis added) in Claim 11 is inaccurate and misdescriptive since the specification describes and FIG. 3 shows that the computer unit 24 is indirectly supported by the clamping member 36 by the legs 40. See MPEP 2173.03.

12. Claims 11-17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichida et al. (EP 1 375 325 A2 cited by Applicant).

Regarding Claim 11, Ichida teaches an electrical bicycle shift control assembly comprising:

a first shift control device 24a (FIG. 2) including a first mounting portion 41 having a first tubular clamping member 41 (see Attachment hereinafter “Att.”) configured to be selectively clamped onto a bicycle handlebar 16 (FIG. 2) and a first electrical shift control switch 40 attached to the first tubular clamping member 41 of the first mounting portion 41; and

a bicycle computer unit 20 including a display screen 20 being indirectly supported by the first tubular clamping member 41 of the first mounting portion 41 such that the computer unit 20 is supported by the bicycle handlebar 16. *Ibid.* paragraph [0027] and claims 26-35.

Ichida teaches the invention as claimed except the display screen 20 being directly supported by the first tubular clamping member. However, Ichida expressly teaches or suggests in paragraph [0027] of the specification that “[f]or example, the cycle computer 20 can be divided into a display unit and a control unit with the control unit mounted at a different location on the bicycle frame from the display unit.” Ichida’s different location broadly includes the location wherein the display unit 20 is directly supported by the first tubular clamping member 41 and indirectly supported by the handlebar 16.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the location of Ichida’s computer unit such that it is directly supported by the first tubular clamping member and indirectly supported by the handlebar as explicitly suggested by Ichida. See rearrangement of parts in MPEP 2144.04. The instant rearrangement would yield no more than predictable results. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007) and *Ex parte Smith*, 83 USPQ2d 1509 (BPAI 2007).

Regarding Claim 12, Ichida teaches second shift control device 24b (*id.* paragraphs [0020] and [0030]) including a second mounting portion 41 having a second tubular clamping member 41 configured to be selectively clamped onto the bicycle handlebar 16 (FIG. 2 of Att.) of the bicycle 10 and a second electrical shift control switch 40 mounted to the second mounting portion 41, the bicycle computer unit being *operatively* supported between the first and second shift control devices 24a and 24b by at least the first mounting portion 40. Note that the first and second shift control devices are substantially identical to each other as described in paragraph [0030].

Regarding Claim 13, the first mounting portion 41 includes a band section (FIG. 9 of Att.) and a computer support leg 16 (FIG. 2 of) extending from the band section, and the bicycle computer unit 20 is attached to the computer support leg 16 of the first mounting portion.

Regarding Claim 14, the computer support leg 16 includes a bent section (FIG. 2 of Att.) such that the bicycle computer unit 20 is longitudinally offset from the band section (FIG. 9 of Att.) along the first bicycle portion (FIG. 2 of Att.).

Regarding Claim 15, the first electrical shift control switch portion 40 includes a first operating member 42 arranged and configured to move relative to the first mounting portion 41 between a first neutral position and a first actuating position. See claims 1-35.

Regarding Claim 16, the operating member 42 is further arranged and configured to be selectively moved relative to the mounting portion 41 between the neutral position (FIG. 4, see Brief Description of the Drawings) and a second actuating position (FIG. 6) that is spaced from the first actuating position (FIG. 5).

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Regarding Claim 17, the electrical shift control switch portion further includes a biasing element 48 arranged and configured to urge the operating member 42 to the neutral position. See paragraph [0032].

13. Claim 11, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Masui (US Patent No. 6,305,241 B1).

Masui teaches an electrical bicycle shift control assembly comprising:

a first shift control device including a first mounting portion 326, 22 (FIG. 7), 426, 22 (FIG. 8) having a first tubular clamping member 326, 22 (FIG. 7), 426, 22 (FIG. 8) configured to be selectively clamped onto a bicycle handlebar 18 and a first electrical shift control switch 390 (FIG. 7), 490 (FIG. 8) attached to the first tubular clamping member 326, 22 (FIG. 7), 426, 22 (FIG. 8) of the first mounting portion 326, 22 (FIG. 7), 426, 22 (FIG. 8); and

a bicycle computer unit 314, 414 including a display screen 314, 414 being directly supported by the first tubular clamping member 326, 22 (FIG. 7), 426, 22 (FIG. 8) of the first mounting portion 326, 22 (FIG. 7), 426, 22 (FIG. 8) such that the bicycle computer 314, 414 is only indirectly supported by the handlebar 18. *Ibid.* col. 5, line 58 through col. 6, line 27, and Claims 1-25.

14. Claims 19-21 are allowed.

15. Claims 1-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 , second paragraph, set forth in this Office action.

16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

17. Applicant's arguments filed August 2 and 10, 2007 have been fully considered but they are not persuasive.

Drawings

The replacement drawings are unacceptable for the reasons set forth above.

Specification Objections

The previous objections to the specification are withdrawn in view of Applicant's amendment to the specification.

35 USC 112

Applicant cancelled the term "removeable" and added the term "slidable" in Claims 1, 18, and 28. The new term "slidable" is indefinite as seen above.

35 USC 102

Rejection 1

The rejection of Claims 1-7 and 11-18 under 35 USC 102(b) as being anticipated by Ichida et al. is withdrawn in view of Applicant's amendment to the claims. Applicant's arguments with respect to this ground of rejection have been considered but are moot in view of the new ground(s) of rejection.

Rejection 2

The rejection of Claims 1, 8-10, and 22-31 under 35 USC 102(e) as being anticipated by Uno et al. is withdrawn in view of Applicant's amendment to the claims.

Rejection 3

The rejection of Claims 1 and 22 under 35 USC 102(e) as being anticipated by Wesling et al. is withdrawn in view of Applicant's amendment to the claims.

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Rejection 4

With respect to the rejection of Claim 11 under 35 USC 102(b) as being anticipated by Matsui et al., Applicant contended:

With respect to the rejection of independent claim 11 based on the Masui et al. patent, Applicant notes that, contrary to the position of the Office Action, *this reference lacks a first electrical shift control switch attached to the first tubular clamping member whatsoever*. Specifically, the so-called electrical shift control *switch portion* is merely a display in this patent. In other words, the Masui et al. patent does not disclose a first electrical shift control switch attached to the first tubular clamping member of the first mounting portion, as now claimed. Thus, the Masui et al. patent fails to disclose or suggest the unique arrangement set forth in independent claim 11, as now amended. (Emphasis added).

The above contention is unsupported by substantial evidence in the record. Indeed, Matsui teaches the first electrical shift control switch 390 (FIG. 7), 490 (FIG. 8) attached to the first tubular clamping member 326, 22 (FIG. 7), 426, 22 (FIG. 8) of the first mounting portion 326, 22 (FIG. 7), 426, 22 (FIG. 8). Thus, the Masui et al. patent discloses or suggests the unique arrangement set forth in independent claim 11 as now amended.

35 USC 103

The rejection of Claims 11, 12, 15-17, and 19-21 under 35 USC 103(a) as being obvious over Uno et al. is withdrawn in view of Applicant's statement that Uno and this application were owned by, or subjected to an obligation of assignment to the same assignee, Shimano, Inc.

Conclusion

For the foregoing, Claims 1-31 are not in condition for allowance.

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18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

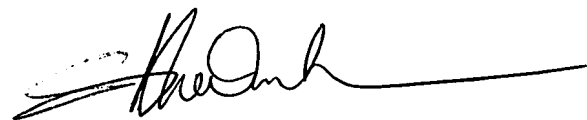
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

October 29, 2007



Vinh T. Luong
Primary Examiner

ATTACHMENT

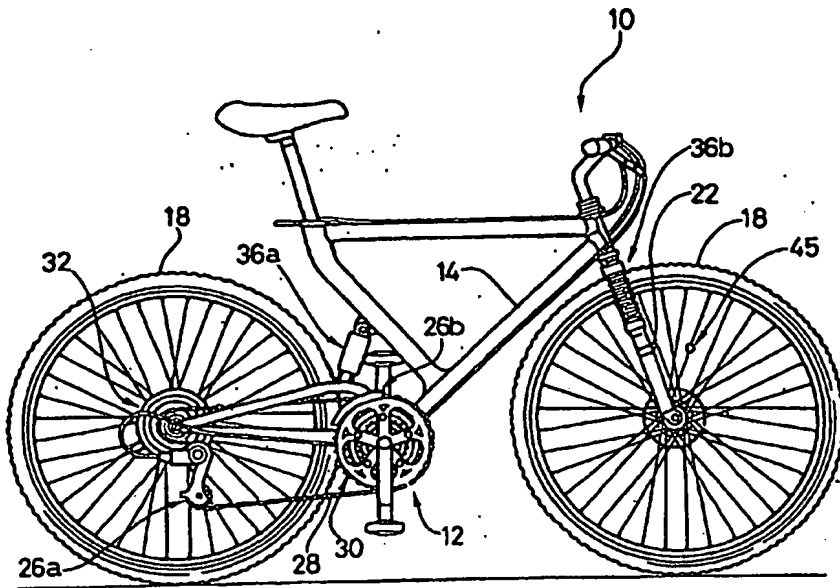


FIG. 1

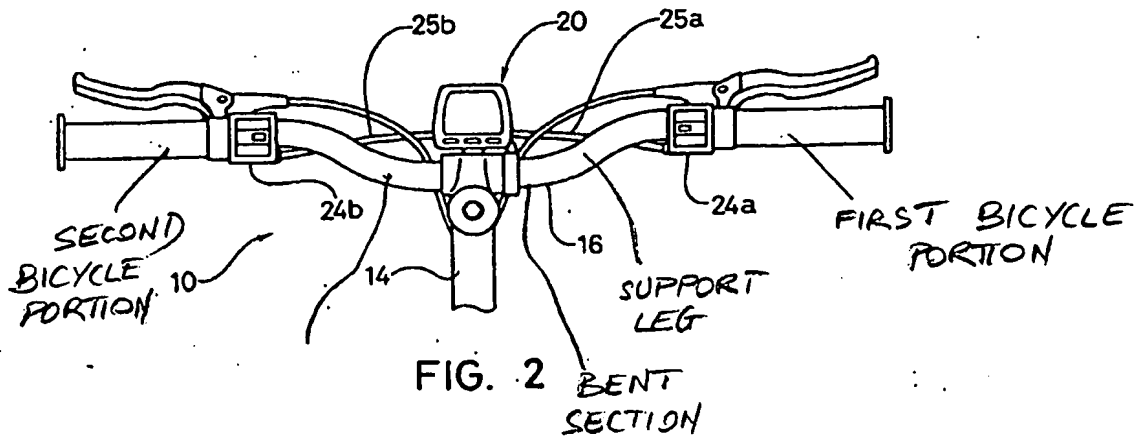
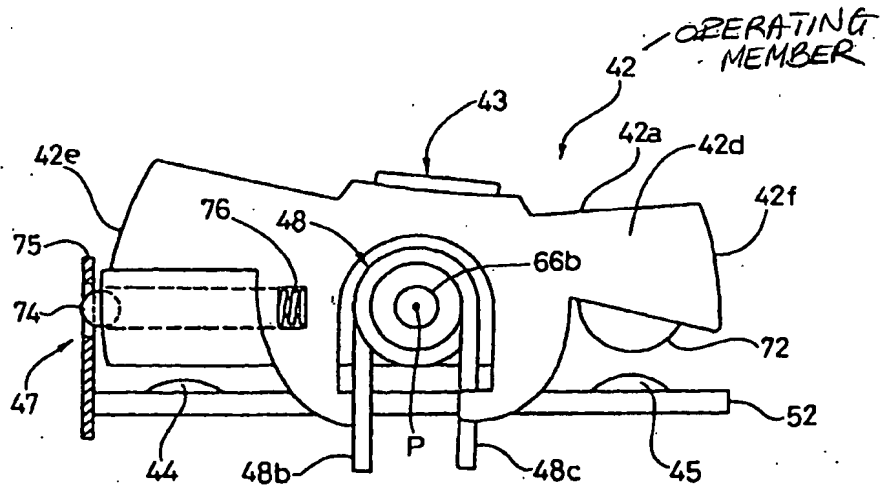
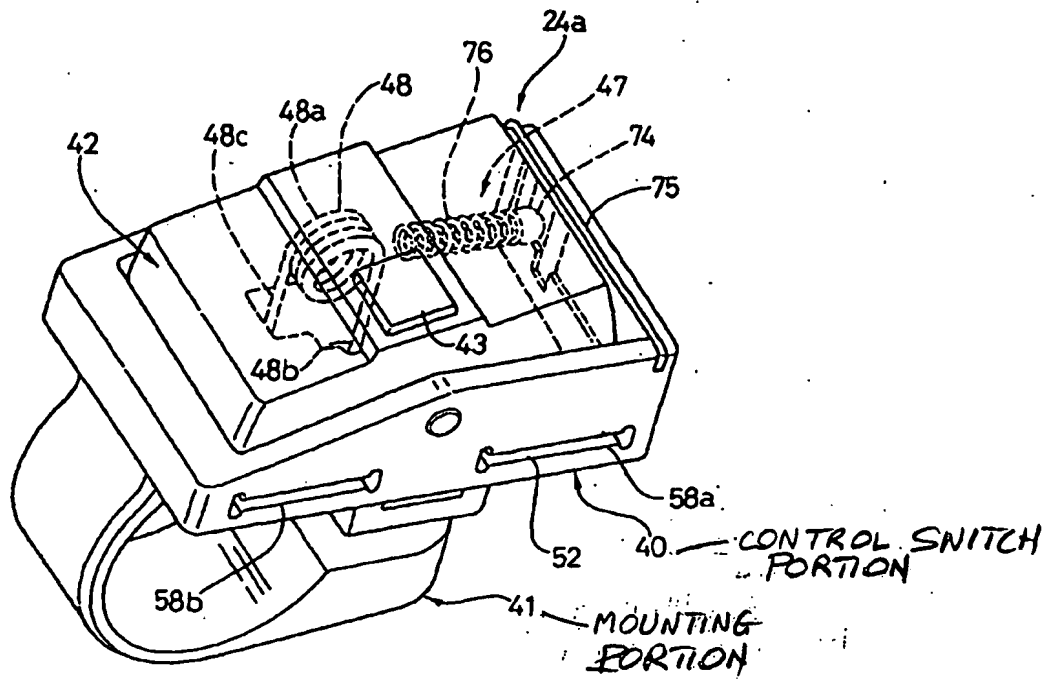


FIG. 2 BENT SECTION



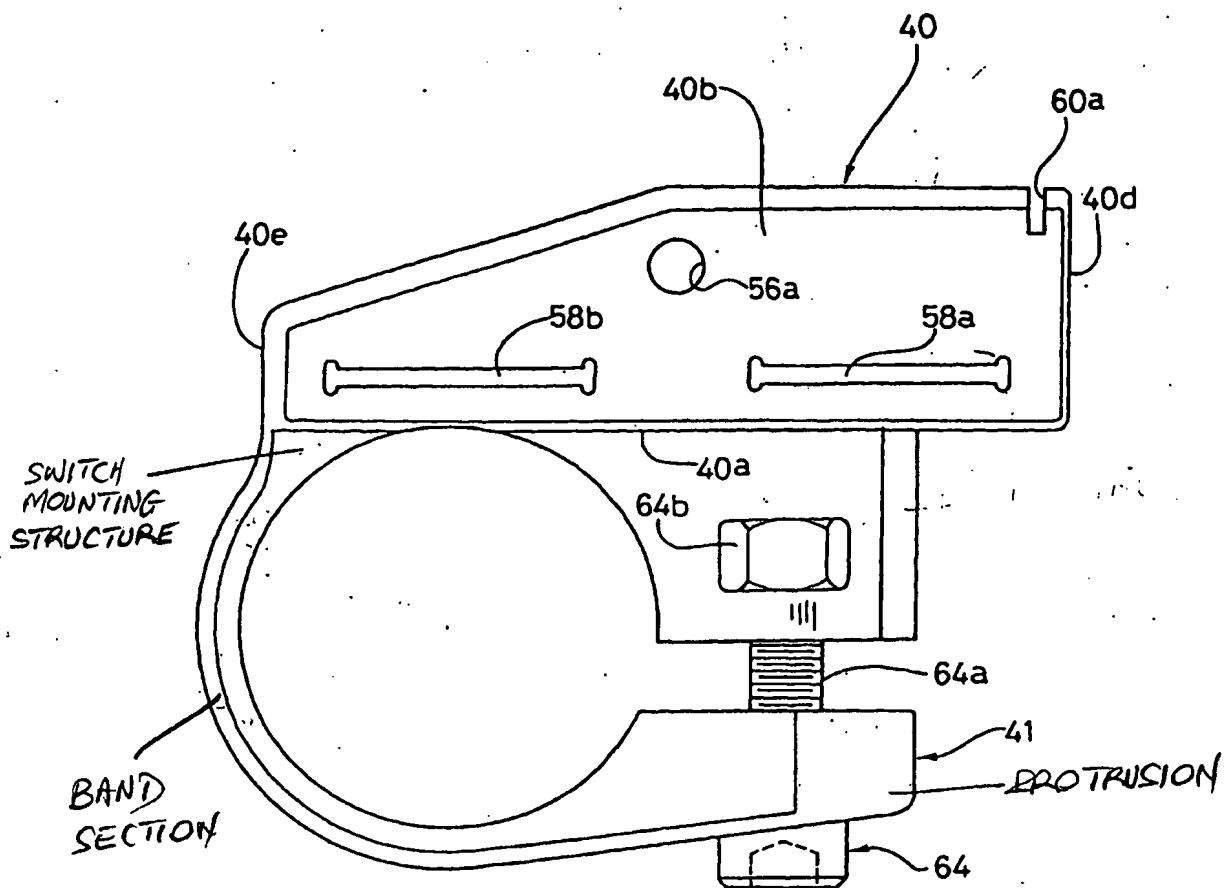


FIG. 9

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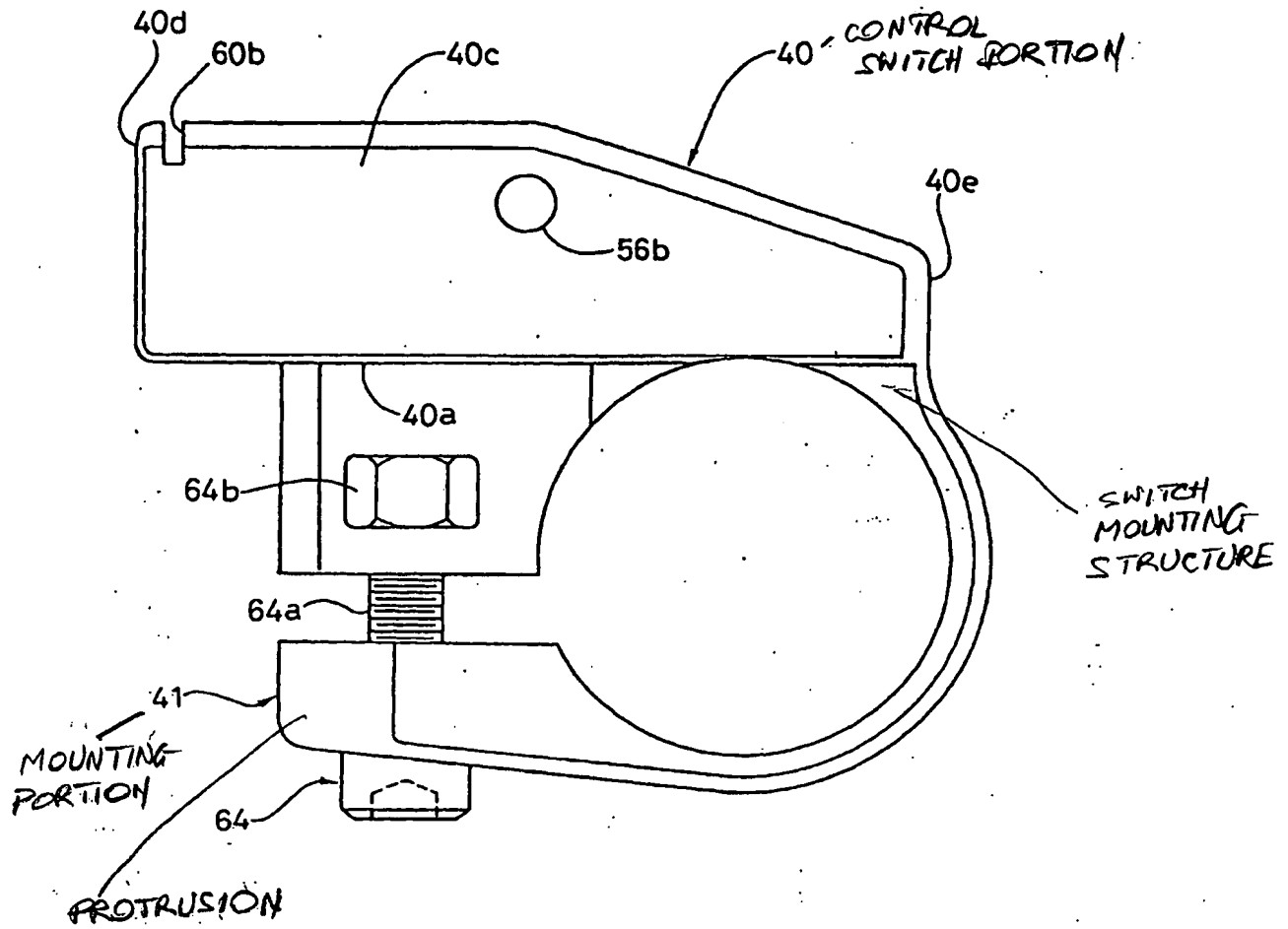


FIG. 10